

REMARKS

Applicants have requested deletion of all handwritten insertions and marks in the copy of the original application filed with this divisional application, thereby obviating the objection thereto.

Reconsideration is requested of the requirement for a new declaration, since the submitted declaration is a true copy of the original in the parent application; and, by the original cross at the legend reading "the specification of which is attached hereto", is believed thereby to have identified that application.

The required substitute and renumbered set of claims has been provided.

Turning, therefore, to the claims, reconsideration is requested of the rejection of claims 12, 15-18 and 21 under 35 U.S.C. 102(b) as being clearly anticipated by Hale (US 4,713,801), and claims 13, 14, 19, 20 and 22, under 35 U.S.C. 103(a) as "obvious" modifications of Hale.

In advancing these grounds of rejection, it is respectfully submitted that the Office has inadvertently read into, and, gratuitously imbued the Hale patent disclosure with, features that are actually totally absent therein; and that, indeed, even if somehow incorporated therein, would actually destroy the patentee's specifically intended operation and construction and even claimed combination of his invention.

To demonstrate this, it is first in order to review what the Hale invention actually purports to be; and how such is structurally achieved, as taught in the specification and drawings and as claimed; and what is actually disclosed in the patent and what is not disclosed (or even operable therein).

The Hale Patent

The objects of invention (col. 2, lines 55-68) are described as to provide

"a compact combination radio receiver, tape player and tape recorder suitable for in-dash installation in an automobile... by which a driver or passenger travelling in a car can directly record radio transmissions on a blank cartridge... while continuing to listen to the radio broadcast... (and) can readily switch from a radio receiving mode to simultaneously receiving and recording a radio transmission and back to the radio receiving mode." (underlining added).

The structure required to accomplish this incorporates the "in-dash mountable AM-FM radio and tape player/recorder" housing with the

"controls for the radio and tape player/recorder... all positioned on one forward face 12 of said rectangular housing." (col. 3, lines 12-21).

The patentee identifies that

"As a minimum, these controls should include a Play button 24, a Pause button 26, and a Record button 32" (col. 4, lines 15-17);

and that the essential operation in accordance with the circuit (Fig. 2) of his invention, requires that

"the automobile driver or a passenger...depresses the Play button 24... (which) simultaneously disengages the power source from the radio receiver and engages the power source to the tape player mechanism as further illustrated in Fig. 2".

The patentee further provides in the circuit and operation of his invention that

"To return to the radio-playing mode of operation, the driver or passenger simply pushes the Pause button 26. One push of the Pause button disengages the power source from the tape player and simultaneously reconnects it to the radio receiver...(and) by pushing the Pause button a second time in a row, the cassette is ejected..." (col. 4, lines 34-42).

The purpose of these sequential circuit connections is so that upon hearing "a song, news broadcast, or other radio programming that he wishes to record", this can be done "simply by pushing one button" also already existing on the front panel push button controls of the dash-board mounted unit.

Then,

"To return to the radio-playing mode of operation after a desired radio broadcast has been recorder, the driver or passenger simply pushes the Pause button 26" (col. 4, lines 65, on), of the front panel existing push button controls.

At this point, two important features of the Hale invention should be emphasized:

(1) that the multiple push-button controls for operation of Hale's invention are intended to be, and indeed, must be those already located in the face of the in-dash mounted radio and tape player/recorder housing unit; and

(2) that the controls must be available to and operable by both the "driver or passenger", as underlined in several quotations, above.

Further to prove that the invention conceived and implemented by Hale require the use of the existing controls located on the dash-board housing, all of Hale's claims specifically requires that location:

Claim 1 (and thus also dependent claims 4, 5 and 6) -- "first, second and third manually-activated controls accessible at said front face" (col. 6, lines 40-42);

Claim 2 -- "said first second and third manually-activated controls are push buttons positioned on an external face of said apparatus" (col. 6, line 48)

Claim 3 (and thus also dependent claim 7) -- to "all of said first, second and third manually-activated controls are positioned on a single external face of said housing means."

Now, as a catch-all, Hale put in a mention that dictation in the car might also be possible:

"the tape player/recorder of this invention may also include a microphone jack or plug designed to accommodate a hand-held microphone for purposes of recording dictation while in transit."

Hale does not, however, show where any such jack or plug can actually be electrically connected in the circuit of Fig. 2, how it becomes operable, or what controls it.

Still, it is quite clear, however, that, in depending his vague "microphone engagement" claim 6 from claim 1, that Hale also intended "manually-activated controls accessible at said front face".

The Section 103 (a) "Obvious" Rejection Of Claims 13, 14, 19, 20 and 22

The Office concedes that

"concerning claims 13, 19 and 22, Hale is silent as to a driver-operated switch control at the steering wheel structure";

and that,

"concerning claims 14 and 20, Hale is also silent as to voice activated switches";

But the Office takes "Official Notice" that "switches on a steering wheel structure and voice activated switches are notoriously old and well known in the media player art".

The Office, however, has not cited a single reference or authority in support of such "Office Notice" of what was known in this context at the time of applicants' original 1990 filing date. Should the Office persist in this fiat, accordingly, such proof is respectfully requested.

Perhaps more telling as to the actual lack of "obviousness" for Hale's purposes is the evidence, as previously documented, as to why Hale "is silent" as to a driver operated control at the steering wheel or voice activated switching.

The reason is very clear that, as above shown, Hale is specifically designed to, and is restricted to using the existing push-button controls sequentially on the dash-board radio/recorder front panel! There is no way ("obviously" or otherwise) a single switch on the steering wheel, either voice-activated or manually operated, can possibly substitute for Hale's required sequence of pressing successive of the plurality of the deck front panel push buttons to practice his disclosed and claimed invention. And again, should the Office persist in this rejection, and because applicants are at a loss to understand how this can possibly be done, as above shown, the Office is respectfully requested to explain how applicants' claimed switch can possibly be connected (and to what part of Hale's circuit of Fig. 2, or otherwise) to achieve this successive sequence of existing push-button radio/recorder circuit operations underlying and required to operate the Hale system.

Under circumstances such as the present case, where not only is there no suggestion or hint in Hale of using applicants' type of steering wheel location switch control, and absolutely no motivation even to consider such, (and, indeed, with a total frustration of Hale's intended invention if somehow incorporated in Hale), the Court of Appeals for the Federal Circuit has again recently criticized the advancing of Sec. 103 (a) "obviousness" type rejections in factual circumstances such as the present case.

In In re Zurko 46 USPQ2d1691 (Fed. Cir.'98), the Federal Court of Appeals for the Federal Circuit has again specifically disapproved of the Patent Office taking the disclosure of a pending application and retrospectively concluding that the invention claimed in it is "obvious" in view of the prior art. The Court found that the Office had impermissibly used "hindsight" to find a step (in that case, obtaining confirmation over a trusted pathway -- in this case, providing a single external steering wheel dictation control) not explicitly taught by the prior art. In the words of the Court:

"while in retrospect, looking at applicants' invention, it might seem logical to perform a repeat-back in the UNIX system over a trusted line, neither Unix nor FILER 2 teaches communicating with the user over a trusted pathway". (at p. 1479).

Paraphrasing, for precisely the same circumstances in the present case:

"while in retrospect, looking at applicants' invention, it might seem logical to perform external steering wheel dictation control, Hale neither teaches such nor can achieve his intended front panel control operation therewith."

And, as earlier stated by that Court In re Gordon, 221 USPQ 1125 (Fed. Cir. '84),

"the mere fact that the prior art could be so modified should not have made a modification obvious unless the prior art suggested the desirability of the modification" (emphasis added).

Again, should the Office persist in this holding, in order to aid applicants' understanding for purposes of further prosecution or appeal, the Office is respectfully requested to point out the specific lines or passages of Hale, that, in the requirement of the Court,

"suggested the desirability of the modification".

Applicants can find no such suggestion whatsoever, and, indeed, such would destroy the heart of Hale's intended invention as earlier shown.

The Sec. 102 (b) Rejection Of
Claims 12, 15-18 and 21
As Anticipated By the Hale Patent

For the above reasons, this rejection is also believed to be entirely improper.

In summarizing the Hale disclosure on page 4 of its letter, indeed, as applied to the above claims, the Office has totally ignored and left out specific limitations in these claims that are not at all disclosed in the Hale patent, are contrary to the Hale disclosure, and that clearly define applicants' novelty over Hale.

Claims 12 clearly requires the microphone and its special recording amplifying components to be "added and permanently integrated in the player tape deck"; claims 15 - 18 recite a "microphone permanently located and integrated in the cassette deck panel"; and claimed 21 similarly calls for "a microphone integrally carried by the front panel", and always driver activated switching of the integrated microphone system.

This is to be contrasted with Hale's add-on concept of an external "hand-held microphone for purposes of recording dictation while in travel" and to be plugged into a "jack or plug" (col. 5, lines 25 - 28), somehow (not disclosed) sharing radio broadcast recording components of the tape deck.

Nor does Hale disclose the further features of driver-activated switching "playback mode... automatically effected a predetermined time after the dictation recording" of dependent claims 17 and 21; or the "playback mode... automatically effected after a predetermined number of recordings" of depending claim 18; or the further limitations in claim

21 to the driver activating dictation switching by voice command at the steering wheel region, as earlier discussed.

Despite the fact that in the parent and continuing applications, the Office has had the opportunity to make and has indeed made multiple prior art searches during the decade since applicants' original 1990 filing date, the Office still has not actually found either any anticipation of applicants' improvement in any patent or publication, or even any actual suggestion by anyone skilled in this art -- and this, even though there are numerous automotive entertainment center developers and manufacturers all over the world striving to improve automobile dashboard centers and expand their functionality.


The patents laws are intended to reward pioneers like applicants, not to thwart the protection to which they are justly entitled.

Reconsideration and allowance are thus believed to be in order and are respectfully requested.

Any costs, including for extensions of time required herein, petition for which is hereby made, are to be charged to Deposit Account No. 18-1425 of the undersigned attorney.

Respectfully submitted,

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